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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,271	12/17/1999	IAN M. DRYSDALE	FDC-0135-PUS	9967
22045	7590	08/02/2006	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			BORLINGHAUS, JASON M	
			ART UNIT	PAPER NUMBER
			3693	

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/466,271

Applicant(s)

DRYSDALE, IAN M.

Examiner

Jason M. Borlinghaus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

To ensure clarity and clear understanding of examiner's rationale for application of cited prior art, terminology contained within parentheses indicates quoted language contained within said cited prior art reference while unquoted language contained within parentheses indicates the general concept as conveyed by said cited prior art reference. Such parenthetical terminology is to be interpreted as "reading on" or being "mapped to" the claim language prior to such parenthetical inclusions.

**Claims 1 – 3, 5 – 8, 10 - 15, 17 - 19 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic (US Patent 5,850,442) in view of PR Newswire

*(General Instrument's Digital Interactive Cable TV Set-Top Terminals To Become The Latest New Acceptance Device For Smart Cards. PR Newswire. New York. December 10, 1998. p.1) and Booker (Booker, Ellis. New System A Welcome Guest at Hyatt. Computerworld. vol. 25, iss. 28. July 15, 1991. pp. 51 – 53).*

**Regarding Claims 1 – 3, 5- 8 and 10**, Muftic discloses a method of performing a card transaction using a transaction card, the method comprising:

- accessing a web server of a merchant service provider (“logged on to a server”) via an Internet service provider using a transaction device (“computer is equipped with a card reader”) during a transaction (“conducting electronic commerce”/“electronic payment”) involving a transaction card (“smartcard” containing “smart tokens”), wherein the web server (“server”) includes commands (programming logic) for processing transaction information (“business transactions”) associated with the transaction card to obtain authorization (“authentication”) from the merchant service provider (“server”) for the transaction; (see col. 7, lines 14 – 64; col. 10, lines 27 – 48; col. 12, lines 5 – col. 14, line 62);
- entering the transaction card into a card reader of the transaction device in order to enter transaction information (“read...smart tokens”) associated with the transaction card into the web server; (see col. 10, lines 27 – 48);
- wherein accessing a web server comprises accessing a web page (“home page”) of the web server, and wherein the web page includes commands

for processing the transaction information ("order information"). (see col. 13, lines 28 – 39);

- further comprising entering ("fills in") additional transaction information ("electronic ID of the seller and the amount") into the web server via the transaction device ("computer"). (see col. 14, lines 37 – 58);
- using a keypad ("keyboard") of the transaction device ("computer"). (see col. 10, lines 27 – 39);
- further comprising displaying information on a display device ("display") of the transaction device ("computer"). (see col. 10, lines 27 – 39);
- wherein displaying information includes displaying an advertisement ("company's home page"/ "yellow pages" listing) downloaded from the Internet ("web"). (see col. 20, lines 10 – 37);
- wherein displaying information includes displaying an electronic coupon ("certificates of insurance") downloaded from the Internet ("network"). (see col. 20, line 68 – col. 21, line 17); and
- further comprising updating the commands of the web server ("loading authentic information into a server"). (see col. 12, lines 5 – 40).

Muftic does not teach underlined limitations – a method comprising:

- entering the transaction card into a card reader of the transaction device in order to enter transaction information associated with the transaction card into the web server during the transaction;

- wherein the transaction device does not utilize any merchant service provider proprietary software for the transaction information to be processed to obtain authorization from the merchant service provider for the transaction;
- wherein the transaction device accesses the web server without accessing any merchant service provider proprietary network.

Muftic does not explicitly teach that the entering of transaction information during the transaction. However, entrance of transaction information during the transaction, rather than before or after the transaction, is old and well known in the art of information technology and security, as separating the entrance of transaction information from the transaction, itself, presents the security risk of unauthorized and/or incomplete transactions due to the temporal separation of entering transaction information and performance of said transaction. Therefore, it would have been obvious to one of ordinary skill in the art to have modified Muftic by incorporating the entrance of transaction information during the transaction, rather than before or after, reducing security risks and possible errors due to separation of these two elements of the transaction.

Utilization and implementation of non-proprietary software to complete card-based transactions is old and well known in the art of computer programming and ecommerce, as evidenced by PR Newswire which discloses the development of the Visa Open Platform, "a flexible non-proprietary platform that enables that fast and easy development of globally interoperable multiple application smart card systems." (see p.

1). The Visa Open Platform has been accepted to allow transaction devices (GSM mobile phones) to complete transactions (load applications onto smart cards). (see p.1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Muftic by incorporating non-proprietary software onto the transaction device to complete the transaction, as disclosed by PR Newswire, allowing "fast and easy development" of said card-based system, furthering Muftic's stated motivation of developing a system for electronic transactions to occur over "an open network." (see col. 1, lines 19 – 22).

Utilization of a non-proprietary network and the benefits of non-proprietary technology and/or software, in general, is old and well known in the art of information technology as evidenced by Booker which discusses the switch from "a proprietary to a nonproprietary wide-area network" that resulted in financial savings "in leasing fees and maintenance" and allowed them "to respond [more] quickly to changes in the marketplace." It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Muftic and PR Newswire to incorporate a non-proprietary network and non-proprietary technology, in general, as disclosed by Booker, to allow the system to capture the benefits of non-proprietary technology.

Furthermore, based upon the benefits of non-proprietary technology and/or software, as disclosed by Booker, one of ordinary skill in the art at the time the invention was made to have further modified Muftic, PR Newswire and Booker by eliminating as much propriety technology and/or software as possible, if not all proprietary technology

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and/or software, from the system to capture the benefits of non-proprietary software and/or technology.

**Regarding Claim 11**, Claim 11 recites similar limitations and/or would have been obvious based upon Claim 1 rejected above, and is therefore rejected using the same art and rationale as applied in the rejection of Claim 1. Differing claim limitations of Claim 11 are taught by Muftic such as a method wherein:

- the transaction information includes an account number associated with the transaction card (“Credit\_Card domain of a smart token...contains identifying information about the credit card company, the account name and number”). (see col. 14, lines 20 – 33).

**Regarding Claims 12 - 15**, further system claims would have been obvious from method claims rejected above, Claims 1, 3 and 5 - 8, and are therefore rejected using the same art and rationale.

**Regarding Claims 17 – 19**, Muftic discloses a method:

- wherein the card transaction involves a smart card. (see col. 10, lines 26 - 48);
- wherein the transaction device comprises a point of service terminal (“terminal”) at a merchant or retail location (“commercial establishments”). (see col. 4, line 60 – col. 5, line 5); and
- further comprising transmitting information (drawing on line of credit/obtaining cash value) to and from a merchant service provider via



the transaction device ("terminal") and the web server ("server"). (see col. 4, line 60 – col. 5, line 5).

**Claims 4, 16 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic, PR Newswire and Booker, as applied to Claims 1 and 15, and further in view of Athing (US Patent 5,987,498).

**Regarding Claims 4, 16 and 20**, Muftic discloses a method of performing a card transaction, the method comprising:

- further comprising entering (inputting) additional transaction information (seller ID and amount). (see col. 14, lines 37 – 58);
- further comprising displaying information on a display device (display) of the transaction device (computer). (see col. 10, lines 27 – 39);
- further comprising providing an electronic signature (digital signature). (see col. 13, lines 40 – 48).

Muftic does not teach underlined limitations - a method of performing a card transaction, the method comprising:

- wherein entering additional transaction information using a touch-sensitive screen of the device;
- wherein the display device comprises a touch-sensitive screen; and
- further comprising providing an electronic signature using a pen and the touch-sensitive screen.

Athing discloses a method of performing a card transaction, the method comprising:

- wherein entering additional information using a touch-sensitive screen of the device. (see col. 6, lines 36 – 46);
- wherein the display device comprises a touch-sensitive screen. (see col. 6, lines 36 – 46); and
- further comprising using a pen (touch-screen pointing device) and the touch sensitive screen. (see col. 6, lines 35 – 46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Muftic and PR Newswire by incorporating conventional input and display devices such as a pen and touch sensitive screen, as disclosed by Athing, to further facilitate communication over the network.

### ***Response to Arguments***

Applicant's arguments filed 5/9/06 have been fully considered but they are not persuasive in part and persuasive in part.

**In response to applicant's argument concerning § 112, 1<sup>st</sup> paragraph,** examiner accepts applicant's amendments and hereby withdraws such rejection.

**In response to applicant's argument that the prior art reference(s) fail to disclose claim limitations as claimed in Claims 1 and 11 - 12,** examiner assumes the applicant means to address pending claims, as currently amended, as such

limitations were only just been incorporated into the pending claims, and were not present when originally rejected.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

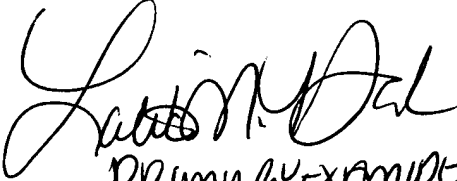
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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PRIMARY EXAMINER, 3693